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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/818,157	03/27/2001	Jose Luis Montero	60001.0043US01	1935
27488	7590	06/18/2004	EXAMINER	
MERCHANT & GOULD P.O. BOX 2903 MINNEAPOLIS, MN 55402-0903			CAMPBELL, JOSHUA D	
			ART UNIT	PAPER NUMBER
			2178	

DATE MAILED: 06/18/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/818,157

Applicant(s)

MONTERO ET AL.

Examiner

Joshua D Campbell

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 March 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date All Listed
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This action is responsive to communications: Application filed on 03/27/2001 and IDSs filed on 05/21/2001, 10/21/2002, 05/09/2003, 01/15/2004, and 05/06/2004.
2. Claims 1-30 are pending in this case. Claims 1, 13, and 24 are independent claims.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:  

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
4. Claims 1, 13, and 17-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As the claims are currently written claim 1 contradicts itself and claim 13 contradicts claims 17-19. As state an entered word is automatically stored in a list, then it is compared to the list to see if it exists in the list. At no point is it possible for the word not to exist in the list since the word was automatically added to the list one step before, thus rendering any spell-checker/auto-completion module completely useless. For the purpose of examination, the examiner has interpreted claims 1 and 13 as they are stated excluding the limitation that pertains to automatically storing the word in a word list in response to the indication. A proper correction will be required to overcome this rejection.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 1-11, 13-22, and 24-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. (hereinafter Miller, US Patent Number 5,896,321) in view of Malik (US Patent Application Publication Number 2002/0065891).

**Regarding independent claim 1**, Miller discloses a method in which an indication that a word has been entered occurs at which point the word is compared with words in a list of words (column 7, lines 7-25 of Miller). Miller does not disclose that the comparison is used to determine the correct spelling. However, Malik discloses a method in which an entered word is compared to find a match in a list in order to

determine if the word is spelled correctly or incorrectly (Page 4, paragraphs 0039-0041 of Malik). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Miller and Malik because it would have allowed for the reduction of errors due to sending emails to the wrong addresses.

**Regarding dependent claim 2,** Miller discloses a method that is stored on a computer readable medium to be executed by a computer (column 1, lines 10-34 of Miller).

**Regarding dependent claim 3,** Miller does not specifically disclose a method in which the words in question are Proper nouns. However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the method on proper nouns because it is notoriously well known that a Proper noun is nothing more than a type of word.

**Regarding dependent claim 4,** Miller does not disclose that the word is an email name. However, Malik discloses that the word can be an email name (Page 4, paragraphs 0039-0041 of Malik).

**Regarding dependent claims 5,** Miller discloses a method in which the indication is generated upon completion of an entry (column 7, lines 7-25). Miller does not disclose that the completion of an entry is based on the resolution of an email name. However, Malik discloses a method in which an indication is made when an item is entered into the TO field of an email which would cause a need for resolution (Page 4, paragraphs 0039-0041 of Malik). As shown by the applicant's disclosure (Background of Invention, paragraph 2) it is well known that upon entry of data into a TO field an

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email is editor will resolve the elements necessary to properly compose the email. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Miller and Malik because it would have allowed for the reduction of errors due to sending emails to the wrong addresses.

**Regarding dependent claim 6-7,** Miller does not disclose a method in which email names are compared in a list. However, Malik discloses comparing an email name to a list of email names, and looking for a match in the list (Page 4, paragraphs 0039-0041 of Malik). At which point the email address and display name could be resolved from the email name. As shown by the applicant's disclosure (Background of Invention, paragraph 2) it is well known that upon entry of data into a TO field an email is editor will resolve the elements necessary to properly compose the email. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Miller and Malik because it would have allowed for the reduction of errors due to sending emails to the wrong addresses.

**Regarding dependent claim 8,** Miller does not disclose a method in which the indication is based on information being entered into the TO field. However, Malik discloses a method in which an indication is made when an item is entered into the TO field of an email (Page 4, paragraphs 0039-0041 of Malik). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Miller and Malik because it would have allowed for the reduction of errors due to sending emails to the wrong addresses.

**Regarding dependent claim 9,** Miller discloses adding the necessary data to the word list to expand the knowledge base of the list (column 7, lines 7-25 of Miller). Miller does not disclose a method in which the added data is a display name of an email. Malik discloses a method in which the list consist of email addresses and as shown by the applicant's disclosure (Background of Invention, paragraph 2) it is well known that the parts of email address can include email names, display names, and the address itself. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Miller and Malik because it would have allowed for the reduction of errors due to sending emails to the wrong addresses.

**Regarding dependent claim 10,** Miller discloses a method in which the word list is a custom dictionary (column 7, lines 7-25 of Miller).

**Regarding dependent claim 11,** Miller discloses a method in which the word list is an auto-completion database (column 5, lines 15-51 and column 7, lines 7-25 of Miller).

**Regarding independent claim 13,** Miller discloses a method in which the word list is a custom dictionary (column 7, lines 7-25 of Miller). Miller discloses a method in which an indication that a word has been entered occurs at which point the word is compared with words in a list of words (column 7, lines 7-25 of Miller). Miller does not disclose a method in which the indication is generated in response to the entry of a display name in a TO field of an email. However, Malik discloses a method in which a entry of a name into a TO field is what causes an indication to start the check (Page 4,



paragraphs 0039-0041 of Malik). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Miller and Malik because it would have allowed for the reduction of errors due to sending emails to the wrong addresses.

**Regarding dependent claim 14**, Miller discloses a method in which an indication of a new word is generated by an email program (column 2, lines 6-52 and column 7, lines 7-25 of Miller).

**Regarding dependent claim 15**, Miller does not disclose a method in which the indication is based on information being entered into the TO field. However, Malik discloses a method in which an indication is made when an item is entered into the TO field of an email (Page 4, paragraphs 0039-0041 of Malik). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Miller and Malik because it would have allowed for the reduction of errors due to sending emails to the wrong addresses.

**Regarding dependent claim 16**, Miller discloses adding the necessary data to the word list to expand the knowledge base of the list (column 7, lines 7-25 of Miller). Miller does not disclose a method in which the added data is a display name of an email. Malik discloses a method in which the list consist of email addresses and as shown by the applicant's disclosure (Background of Invention, paragraph 2) it is well known that the parts of email address can include email names, display names, and the address itself. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Miller and Malik because it

would have allowed for the reduction of errors due to sending emails to the wrong addresses.

**Regarding dependent claim 17-19,** Miller discloses a method in which an indication that a word has been entered occurs at which point the word is compared with words in a list of words (column 7, lines 7-25 of Miller). Miller does not disclose that the comparison is used to determine the correct spelling. However, Malik discloses a method in which an entered word is compared to find a match in a list in order to determine if the word is spelled correctly or incorrectly (Page 4, paragraphs 0039-0041 of Malik). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Miller and Malik because it would have allowed for the reduction of errors due to sending emails to the wrong addresses.

**Regarding dependent claim 20 and 21,** Miller discloses a method in which the word may have been entered into the body of an email note or a word processing document among other things (column 1, lines 35-47 of Miller).

**Regarding dependent claim 22,** Miller discloses a method in which the word list is an auto-completion database (column 5, lines 15-51 and column 7, lines 7-25 of Miller).

**Regarding independent claim 24,** Miller discloses a method in which an indication is given when a new item is available (column 7, lines 7-25 of Miller). Miller does not disclose that the new item is a resolved email name. Malik discloses a method in which email addresses are entered (Page 4, paragraphs 0039-0041 of Malik) and as shown by the applicant's disclosure (Background of Invention, paragraph 2) it is well

known that the parts of email address can include email names, display names, and the address itself. It is well known in the art to use cache to store temporary data to be used in the future for processing. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Miller and Malik because it would have allowed for the reduction of errors due to sending emails to the wrong addresses.

**Regarding dependent claims 25 and 26,** Miller does not disclose a method in which the other module is a spell checker. However, Malik discloses a method in which the module is a spell-checker (Page 4, paragraphs 0039-0041 of Malik). Malik discloses a method in which the list consist of email addresses and as shown by the applicants disclosure (Background of Invention, paragraph 2) it is well known that the parts of email address can include email names, display names, and the address itself. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Malik and Miller because it would have allowed for the reduction of errors due to sending emails to the wrong addresses.

**Regarding dependent claims 27 and 28,** Miller discloses an auto-completion module (column 5, lines 15-51 and column 7, lines 7-25 of Miller). Miller does not disclose that the auto-completion module extracts the displayed name from the email name. However, Malik discloses a method in which the module is a spell-checker (Page 4, paragraphs 0039-0041 of Malik). Malik discloses a method in which the list consist of email addresses and as shown by the applicants disclosure (Background of Invention, paragraph 2) it is well known that the parts of email address can include

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email names, display names, and the address itself. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Malik and Miller because it would have allowed for the reduction of errors due to sending emails to the wrong addresses.

8. Claims 12, 23, and 29-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miller et al. (hereinafter Miller, US Patent Number 5,896,321) in view of Malik (US Patent Application Publication Number 2002/0065891) as applied to claims 9, 13, and 24 above, and further in view of Beauregard et al. (IDS - hereinafter Beauregard, US Patent Number, 5,974,413).

**Regarding dependent claims 12 and 23**, neither Miller nor Malik disclose the use of a smart tags database. However, Beauregard discloses a method in which words can be stored in a semantic database (smart tag) which allows every word to be tied to an action (column 4, line 34-column 6, line 20 of Beauregard). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the methods of Miller and Malik with the method of Beauregard because it would have increased the functionality of words in the system.

**Regarding dependent claims 29 and 30**, Miller does not disclose a method in which the other module is a smart tags database. Malik discloses a method in which the list consist of email addresses and as shown by the applicants disclosure (Background of Invention, paragraph 2) it is well known that the parts of email address can include email names, display names, and the address itself. Beauregard discloses

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a method in which words can be stored in a semantic database (smart tag) which allows every word to be tied to an action (column 4, line 34-column 6, line 20 of Beauregard).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have used the methods of Miller and Malik with the method of Beauregard because it would have increased the functionality of words in the system.

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US Patent Number 5,761,689

US Patent Number 5,805,911

US Patent Number 5,875,443

US Patent Number 5,892,919

US Patent Number 6,556,984

US Patent Application Publication Number 2002/0091803

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D Campbell whose telephone number is (703)305-5764. The examiner can normally be reached on M-F (8:00 AM - 4:30 PM).

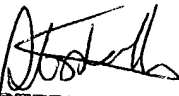
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (703)308-5186. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

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JDC  
June 3, 2004

  
STEPHEN S. HOHN  
PRIMARY EXAMINER